

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: WALLACH et al

Application No.: 08/485,129

Filed: June 7, 1995

For: ISOLATED DNA ENCODING TUMOR NECROSIS FACTOR

THE COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

Sir:

Transmitted herewith is an [ ] Amendment [XX] Response to Notification of Non-Compliance with 37 C.F.R. 1.192(c) and Brief on Appeal in triplicate in the above-identified application.

- [ ] Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted
- [ ] A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.
- ~~[XX]~~ No additional fee is required.
- [ ] The fee has been calculated as shown below:

	(Col. 1) CLAIMS REMAINING AFTER AMENDMENT	(Col. 2) HIGHEST NO. PREVIOUSLY PAID FOR	(Col. 3) PRESENT EXTRA EQUALS
TOTAL	*	MINUS	** 20
INDEP.	*	MINUS	*** 3
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM			

ADDITIONAL FEE TOTAL

SMALL ENTITY		OR	OTHER THAN SMALL ENTITY	
RATE	ADDITIONAL FEE		RATE	ADDITIONAL FEE
x 9	\$		x 18	\$
x 39	\$		x 78	\$
+ 130	\$		+ 260	\$
		OR		
				TOTAL
				\$

- \* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
- \*\* If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.
- \*\*\* If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[ ] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

- [ ] First - \$ 55.00
- [ ] Second - \$ 190.00
- [ ] Third - \$ 435.00
- [ ] Fourth - \$ 680.00

Month After Time Period Set

[ ] Less fees (\$ \_\_\_\_\_) already paid for \_\_\_\_ month(s) extension of time on \_\_\_\_\_.

Other Than Small Entity

Response Filed Within

- [ ] First - \$ 110.00
- [ ] Second - \$ 380.00
- [ ] Third - \$ 870.00
- [ ] Fourth - \$ 1360.00

Month After Time Period Set

[ ] Please charge my Deposit Account No. 02-4035 in the amount of \$ \_\_\_\_\_.

[ ] A check in the amount of \$ \_\_\_\_\_ is attached (check no. \_\_\_\_\_).

The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK

Attorneys for Applicant(s)

By: Roger L. Browdy  
Roger L. Browdy  
Registration No. 25,618

Facsimile: (202) 737-3528  
Telephone: (202) 628-5197

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

WALLACH et al

Appln. No.: 08/485,129

Filed: June 7, 1995

For: ISOLATED DNA ENCODING TUMOR)  
NECROSIS FACTOR BINDING )  
PROTEIN II, AND VECTORS, )  
HOSTS AND PROCESSES USING )  
SUCH DNA )



Art Unit: 1644

Examiner: R. Schwadron

Washington, D.C.

March 23, 2000

Atty.Docket: WALLACH=5B

RESPONSE TO NOTIFICATION OF NON-COMPLIANCE  
WITH 37 C.F.R. §1.192(c)

Honorable Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

On March 10, 2000, the PTO mailed a paper entitled Notification of Non-Compliance with 37 C.F.R. §1.192(c). The examiner stated that the brief does not contain the items required under 37 C.F.R. §1.192(c) or the items are not under the proper heading or in the proper order, and that the brief does not comply with 37 C.F.R. §1.192(c)(3), (c)(4), or (c)(5). The examiner specifically stated that the brief does not disclose the status of claims 2-10 and 15-33, nor does it disclose the status of the amendments after final filed November 3, 1997, and March 31, 1998, and the section "Related Appeals and Interferences" does not refer to the interference proceeding involving parent application 07/930,443.

Attached hereto is a new complete brief in triplicate. The statement of the Status of Claims has been amended to refer to all of the cancelled claims, and the section on the Summary of the Invention now refers to the specification by page and line number.

As to the section "Related Appeals and Interferences", it is only necessary to refer to such a related appeal or interference if applicants believe that the related appeal or interference will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. While applicants do not believe that the interference involving the parent case satisfies this requirement, nevertheless, at the urging of the examiner, this section of the brief has been amended to refer to the interference involving the parent application.

It is not understood why the examiner checked the box in paragraph 1 of the notification form, as the brief does indeed contain all of the items required under 37 C.F.R. §1.192(c) and they appear under the proper headings and in the proper order. There is nothing in 37 C.F.R. §1.192 which states that applicant cannot add additional items under appropriate headings. As long as all of the items required by 37 C.F.R. §1.192(c) are present and in the order specified, 37 C.F.R. §1.192(c) has been fully complied with. See the discussion in the Notice of May 3, 1988, 1092 O.G. 26-35, relating to the rulemaking of this rule, where it states:

Two commenters expressed the concern that §1.192(c) does not permit the inclusion in a brief of any items other than the seven items specified. Other commenters suggested that

other items be included, such as a list of the references, table of contents, table of cases, etc. It should be emphasized that §1.192(c) merely specifies the minimum requirements for a brief, and does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable. A brief is in compliance with §1.192(c) as long as it includes items (1) to (7) in the order set forth (with the appendix, item (7), at the end).

As to the "Status of Amendments" section, it is urged that this section of 37 C.F.R. §1.192(c) only intends to refer to amendments filed after the most recent final rejection in the case, as it is only these claims where any ambiguity may arise as to their current status. There is no necessity for the Board to know what happened to amendments filed after previous final rejections which were subsequently withdrawn. Nevertheless, in order to obviate this requirement of the examiner, the Board has been given a full history of all amendments after final rejection throughout the prosecution history of this case.

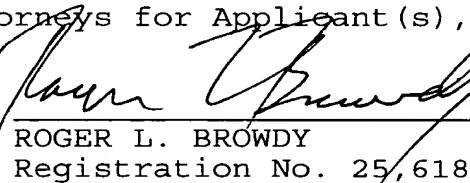
Accordingly, the attached revised brief now fully complies with 37 C.F.R. §1.192(c). Entry of this brief and action thereon is therefore earnestly solicited.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.

Attorneys for Applicant(s),

By:

  
ROGER L. BROWDY  
Registration No. 25,618

RLB:al  
624 Ninth Street, N.W., Suite 300  
Washington, D.C. 20001  
Telephone No.: (202) 628-5197  
Facsimile No.: (202) 737-3528

roger\brie\fs\wall5b.res